

Serial No.: 09/918,326

Art Unit: 2137

**REMARKS**

This is a full and timely response to the outstanding Advisory Action mailed August 29, 2005 and the final Office Action mailed June 10, 2005. Reconsideration and allowance of the application and presently pending claims 1-16, as amended, are respectfully requested.

1. Response To Rejections of Claims 11 and 15-16 Under 35 U.S.C. §102

Claims 11 and 15-16 have been rejected under 35 U.S.C. §102(e) as being anticipated by *DeBry* (U.S. Patent No. 6,385,728). Applicants respectfully traverse this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed subject matter must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. §102(e). In the present case, not every feature of the claimed subject matter is represented in the *DeBry* reference. Applicants discuss the *DeBry* reference and Applicants' claims in the following.

a. Claim 11

As provided in independent claim 11, Applicants claim:

A method of authenticating the identity of a sender of a received digital document, the method comprising:

*using a unique identifier printed on the received document to search for a corresponding record in a list of received document records;*

*referencing a digital certificate associated with the selected record, the certificate being one of a store of certificates of received documents and each digital certificate being associated with a most recent sender of the received digital document;*

receiving an encrypted digest of the received digital document;  
decrypting the encrypted digest;

computing a value of a second digest from the received digital document;

comparing the computed value of the second digest with a value of the decrypted digest; and

Serial No.: 09/918,326  
Art Unit: 2137

carrying out an on-line authentication of the certificate when the computed value of the second digest corresponds with the value of the decrypted digest.

(Emphasis added).

Applicants respectfully submit that independent claim 11 is allowable for at least the reason that *DeBry* does not disclose, teach, or suggest at least "using a unique identifier printed on the received document to search for a corresponding record in a list of received document records" and "referencing a digital certificate associated with the selected record, the certificate being one of a store of certificates of received documents and each digital certificate being associated with a most recent sender of the received digital document," as recited and emphasized above in claim 11.

Rather, *DeBry* discloses at most a system where "[u]pon receiving a request to print a document, the document source 10, or owner of the document, will create a will-call certificate based upon that specific user request, and will give the requesting user a will-call certificate." Col. 7, lines 15-19. The will-call certificate contains "the digital signature of the provider of the document 43." Col. 7, lines 20-25. Later, "[w]hen the document source 10 receives the will-call certificate, the document source can verify that this certificate is indeed one that was originally issued by the document source. The document source knows that the digital signature is one that only the document source could have generated using its private key." Col. 8, lines 6-9 (Emphasis added). Further, *DeBry* discloses that "the document source can keep its own log or database for each will-call certificate issued." Col. 8, lines 20-27.

Accordingly, *DeBry* fails to teach or suggest using a unique identifier printed on the received document (such as a will-call certificate in *DeBry*), to search for a corresponding record in a list of received document records (such as a database or log of will-call certificates in *DeBry*) and referencing a digital certificate associated with the selected record, the certificate being one of a store of certificates of received documents and each digital certificate being associated with a most recent sender of the received digital document, since the digital signature in *DeBry* is not associated with a most recent sender of the received digital document (such as the print server 30 in *DeBry* that sends a will-call certificate 40 to the document source 10). In contrast, the digital signature in *DeBry* is associated with the owner or source of a document

Serial No.: 09/918,326  
Art Unit: 2137

being requested and not the most recent sender of the will-call certificate that is received by the document source.

In particular, FIG. 1 shows that a user 20 sends a print request (1) to a document source 10; document source 10 sends (2) a will-call certificate to a user 20; user 20 sends (3) a print request (will-call) to a print server 30; a print server 30 sends (4) a document request (will-call and server certificate) to document source 10; and the document source 10 sends (5) a document X to the print server 30. Accordingly, *DeBry* teaches that the most recent sender of the will-call certificate to the document source 10 is the print server 30 and not the document source 10.

Therefore, *DeBry* does not teach or suggest at least all of the claimed features of claim 11. Therefore, claim 11 is not anticipated by *DeBry*, and the rejection should be withdrawn for at least this reason alone.

b. Claims 15-16

Because independent claim 11 is allowable over the cited art of record, dependent claims 15-16 (which depend from independent claim 11) are allowable as a matter of law for at least the reason that dependent claims 15-16 contain all the steps and features of independent claim 11. For at least this reason, the rejections of claims 15-16 should be withdrawn.

2. Response to Rejection of Claims 1-10 and 12-14 Under 35 U.S.C. §103

In the Office Action, claims 1-4, 8-10, and 12-13 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *DeBry* in view of *Mandelbaum* (EP Patent 0671830A2). Claims 5-7 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *DeBry* in further view of *Fischer* (EP Patent 0386867B1). Claim 14 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *DeBry*. It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Serial No.: 09/918,326

Art Unit: 2137

a. Claim 1

As provided in independent claim 1, Applicants claim:

A document printout device for receiving and printing out digital documents, the printout device comprising:

a store of digital certificates, each certificate being associated with a received digital document and a most recent sender of the received digital document;

an audit log comprising a list of received document entries, each entry containing a reference to one of the certificates in the store, an encrypted digest corresponding to the received digital document of that entry, and a unique identifier associated with the received digital documents;

a decryption algorithm for decrypting the received encrypted digest associated with one of the received digital document selected for verification; and

*a hash algorithm for creating a digest of the selected digital document such that when the created digest corresponds to the decrypted digest, the digital certificate of the most recent sender is authenticated.*

(Emphasis added).

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *DeBry* in view of *Mandelbaum* does not disclose, teach, or suggest at least "a hash algorithm for creating a digest of the selected digital document such that when the created digest corresponds to the decrypted digest, the digital certificate of the most recent sender is authenticated," as recited and emphasized above in claim 1.

Rather, *DeBry* discloses at most a system where "[u]pon receiving a request to print a document, the document source 10, or owner of the document, will create a will-call certificate based upon that specific user request, and will give the requesting user a will-call certificate." Col. 7, lines 15-19. The will-call certificate contains "the digital signature of the provider of the document 43." Col. 7, lines 20-25. Later, "[w]hen the document source 10 receives the will-call certificate, the document source can verify that this certificate is indeed one that was originally issued by the document source. The document source knows that the digital signature is one that only the document source could have generated using its private key." Col. 8, lines 6-9 (Emphasis added). Further, *DeBry* discloses that the "document source can then apply the same hash function to the contents of the received will-call certificate and compare the resulting hashes to ensure that no data . . . in the will-certificate was

Serial No.: 09/918,326

Art Unit: 2137

changed after the document source signed the will-call certificate." Col. 8, lines 15-20 (Emphasis added).

Accordingly, *DeBry* fails to teach or suggest "a hash algorithm for creating a digest of the selected digital document such that when the created digest corresponds to the decrypted digest, the digital certificate of the most recent sender is authenticated," since the *DeBry* system authenticates the receiver (e.g., document source 10) of a will-call certificate, and not the most recent sender. To illustrate, FIG. 1 shows that a user 20 sends a print request (1) to a document source 10; document source 10 sends (2) a will-call certificate to a user 20; user 20 sends (3) a print request (will-call) to a print server 30; a print server 30 sends (4) a document request (will-call and server certificate) to document source 10; and the document source 10 sends (5) a document X to the print server 30. Accordingly, *DeBry* teaches that the most recent sender of the will-call certificate to the document source 10 is the print server 30 and not the document source 10.

In that *Mandelbaum* is legally inadequate to cure all of the deficiencies of the *DeBry* reference, a *prima facie* case establishing an obviousness rejection by *DeBry* in view of *Mandelbaum* has not been made. Accordingly, claim 1 is not obvious under the proposed combination of *DeBry* in view of *Mandelbaum*, and the rejection should be withdrawn.

b. Claims 2-9 and 12-13

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-9 and 12-13 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-9 and 12-13 contain all the elements and features of independent claim 1. Further, *Fischer* is legally inadequate to the cure deficiencies of the *DeBry* reference with regard to claims 5-7 and others. For at least this reason, the rejections of claims 2-9 and 12-13 should be withdrawn.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 2-9 and 12-13, these dependent claims recite further features/steps and/or combinations of features/steps (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

Serial No.: 09/918,326  
Art Unit: 2137

c. Claim 10

As provided in independent claim 10, Applicants claim:

In a facsimile machine adapted for receiving and printing out digital documents, a device comprising:

*a store of digital certificates, each certificate being associated with a most recent sender of a received digital document; and*

*an audit log comprising a list of received document entries, each entry containing a reference to one of the certificates in the store and a unique identifier associated with a received digital document.*

(Emphasis added).

Applicants respectfully submit that independent claim 10 is allowable for at least the reason that *DeBry* in view of *Mandelbaum* does not disclose, teach, or suggest at least "a store of digital certificates, each certificate being associated with a most recent sender of a received digital document," as recited and emphasized above in claim 10.

Rather, *DeBry* discloses at most a system where "[u]pon receiving a request to print a document, the document source 10, or owner of the document, will create a will-call certificate based upon that specific user request, and will give the requesting user a will-call certificate." Col. 7, lines 15-19. The will-call certificate contains "the digital signature of the provider of the document 43." Col. 7, lines 20-25. Later, "[w]hen the document source 10 receives the will-call certificate, the document source can verify that this certificate is indeed one that was originally issued by the document source. The document source knows that the digital signature is one that only the document source could have generated using its private key." Col. 8, lines 6-9 (Emphasis added). Further, *DeBry* discloses that "the document source can keep its own log or database for each will-call certificate issued." Col. 8, lines 20-27. (Emphasis added).

Accordingly, *DeBry* fails to teach or suggest "a store of digital certificates, each certificate being associated with a most recent sender of a received digital document," since *DeBry* discloses a log or database for each will-call certificate issued, and not received. In that *Mandelbaum* is legally inadequate to cure all of the deficiencies of *DeBry*, a *prima facie* case establishing an obviousness rejection by *DeBry* in view of *Mandelbaum* has not been made. Accordingly, claim 10 is not

Serial No.: 09/918,326  
Art Unit: 2137

obvious under the proposed combination of *DeBry* in view of *Mandelbaum*, and the rejection should be withdrawn.


d. Claim 14

Because independent claim 11 is allowable over the cited art of record, dependent claim 14 (which depends from independent claim 11) is allowable as a matter of law for at least the reason that claim 11 contains all the steps and features of independent claim 11 and the cited art is legally inadequate to the cure deficiencies of the *DeBry* reference. For at least this reason, the rejections of claim 14 should be withdrawn.

**CONCLUSION**

For at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

  
Charles W. Griggers  
Reg. No. 47,283